

**REMARKS**

Claims 1-12, 14-16 and 20-32 are pending in this application. Claims 20-32 have been withdrawn from consideration. By this Amendment, claims 1 and 8 are amended. Claim 13 is canceled without prejudice to, or disclaimer of, the subject matter recited in that claim. Support for the amendments can be found in the claims as originally filed (see claim 13). No new matter is added.

Applicant appreciates the courtesies shown to Applicant's representative by Examiner Walters in the April 26, 2010 telephone conference. Applicant's separate record of the substance of the telephone conference is incorporated into the following remarks.

In view of the foregoing amendments and the following remarks, reconsideration and allowance of the claims are respectfully requested.

**I. Allowable Subject Matter**

The Office Action, at page 8, indicates that claims 6-8 and 10-12 recite allowable subject matter. Specifically, these claims are indicated as allowable if rewritten in independent form to include all of the features of the base claim and any intervening claims. Applicant appreciates this indication of allowability, but respectfully submits that at least claim 1, from which these claims depend, and the other claims depending from claim 1, are allowable for at least the reasons presented below.

**II. Rejection Under 35 U.S.C. §112**

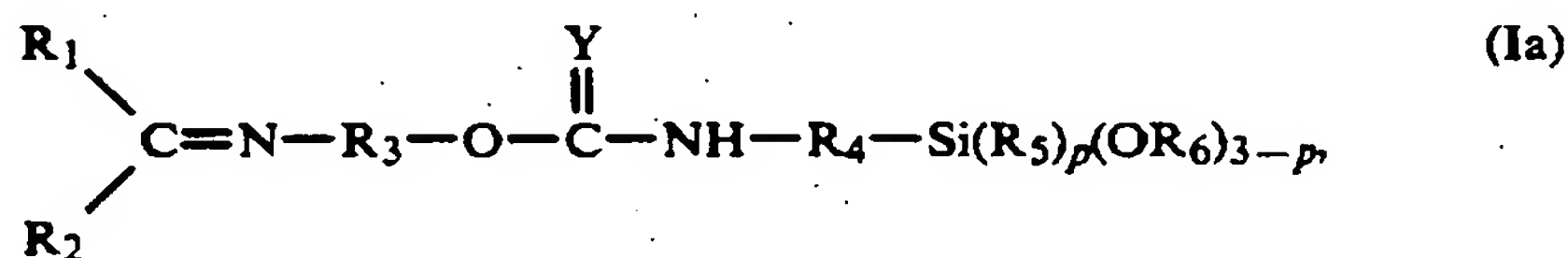
The Office Action rejects claims 1-16 under 35 U.S.C. §112, second paragraph, as allegedly being indefinite. By this Amendment, claim 1 is amended to incorporate the subject matter of claim 13 to obviate the rejection as briefly discussed, and agreed upon, during the April 26, 2010 telephone conference between Applicant's representative and Examiner Walters. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

### III. Rejections Under 35 U.S.C. §§102/103

The Office Action rejects claims 1, 3, 4, 9 and 13 under 35 U.S.C. §102(b) or, in the alternative, under 35 U.S.C. §103(a) over U.S. Patent No. 5,134,234 to Parrinello et al. ("Parrinello"). Claim 13 is canceled, thus rendering the rejections moot as to that claim. As to the remaining claims, these rejections are respectfully traversed. For at least the reasons presented below, Parrinello does not disclose, and would not have rendered obvious, the above combination of features recited in claim 1.

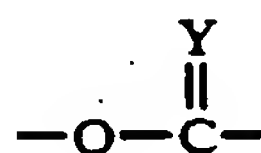
The silanes of Parrinello are prepared by the reaction of an isocyanatosilane of formula (Va) with an iminoalcohol of formula (VI) (Parrinello, col. 6, lines 15-33). In contrast, the aldiminoalkylsilane ALS recited in claim 1 is prepared by an entirely different reaction between an aminosilane and an aldehyde, which results in an entirely different product.

More specifically, Parrinello discloses compounds of general formula (Ia):



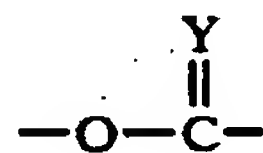
**Formula (Ia) of U.S. Patent No. 5,132,234 to Parrinello et al.**

having the following structural element between the silane group and the imino group:



that is not present in the aldiminoalkylsilane ALS, as recited in claim 1.

It is well established that a genus anticipates a species if one of ordinary skill in the art is able to “envisage” the claimed species within the disclosed genus. *See, e.g.* MPEP § 2131.02; and *In re Petering*, 301 F.2d 676, 133 USPQ 275 (CCPA 1962). Based on the above, Parrinello fails to disclose an aldiminoalkylsilane **ALS** prepared from the reaction of at least one aminoalkylsilane **AS** of formula (I) and at least one aldehyde **ALD** of formula (II), the aldiminoalkylsilane **ALS** having the formula (VII) or (VIII), as recited in claim 1. Put differently, the iminosilanes of Parrinello, as shown in Formula (Ia) of Parrinello, does not anticipate the aldiminoalkylsilane **ALS** as recited in claim 1. Each and every one of Parrinello's disclosed embodiments contain the following structural group:



that is not present in the compound as recited in claim 1.

Moreover, Parrinello does not provide any reason for one of ordinary skill in the art to have modified its disclosure to obtain the aldiminoalkylsilane **ALS**, as recited in claim 1, without the benefit of Applicant's disclosure.

In view of the foregoing, Parrinello fails to disclose, and thus does not anticipate, each and every feature of claim 1, nor would Parrinello have rendered obvious the above features of claim 1. The remaining claims variously depend from claim 1 and, likewise, also are not anticipated and would not have been rendered obvious by Parrinello, for at least the reasons set forth above, as well as for the additional features they recite.

Accordingly, reconsideration and withdrawal of the rejections are respectfully requested.

**IV. Rejections Under 35 U.S.C. §103****A. Okuhira**

The Office Action rejects claims 1-5, 9 and 13-15 under 35 U.S.C. §103(a) over EP 0985693 to Okuhira et al. ("Okuhira"). Claim 13 is canceled, thus rendering its rejection moot. As to the remaining claims, this rejection is respectfully traversed. For at least the reasons presented below, Okuhira would not have rendered obvious at least the above combination of features recited in claim 1.

The Office Action asserts that Okuhira discloses various features recited in claim 1, but concedes that Okuhira fails to disclose an aldiminoalkylsilane where Y<sup>3</sup> is an alkyl chain of at least 10 carbon atoms, as recited in claim 1 (Office Action, page 6). The Office Action asserts that it would have been allegedly obvious for one of ordinary skill in the art to have modified the disclosure of Okuhira because the simple substitution of an alkyl chain of 10 carbon atoms would be expected to provide an aldiminoalkylsilane having the same or nearly identical properties to an aldiminoalkylsilane of 6 carbon atoms (*Id.*). However, it is respectfully asserted that such an assertion by the Office Action is overly broad and erroneous, for at least the reasons presented below.

Specifically, Applicant has demonstrated through Comparative Examples ALS7 and ALS8 that aldiminoalkylsilanes having short chain aldimines result in significantly lower storage stability, with an increase in viscosity well above 100% (see specification, page 39 and Tables 1 and 2). As a result, any alleged substitution of Okuhira's alkyl of 1 to 6 carbon atoms with an alkyl chain of 10 carbon atoms or more, as recited in claim 1, is certainly not a mere substitution that would allegedly provide the "same or nearly identical properties," as asserted by the Office Action (Office Action, page 6). To assert that one of ordinary skill in the art would have modified the disclosure of Okuhira to replace Okuhira's alkyl of 1 to 6 carbon atoms with an alkyl chain of 10 carbon atoms or more, without any reason or rationale

in the applied reference to have made such a modification, is impermissible hindsight reasoning based solely upon Applicant's disclosure and thus does not constitute a showing of *prima facie* obviousness.

Based on the above, Okuhira would not have rendered claim 1 obvious. The remaining claims variously depend from claim 1 and, likewise, also would not have been rendered obvious by Okuhira for at least the reasons set forth above, as well as for the additional features that they recite. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

**B. Okuhira and Merger**

The Office Action rejects claim 16 under 35 U.S.C. §103(a) over Okuhira in view of U.S. Patent No. 4,853,454 to Merger et al. ("Merger"). This rejection is respectfully traversed.

The Office Action applies Merger as allegedly disclosing additional features recited in dependent claim 16 and, thus, Merger is not applied to cure the deficiencies of Okuhira with respect to claim 1.

Based on the above, Okuhira and Merger, in combination, would not have rendered claim 1 obvious. Claim 16 depends from claim 1 and, likewise, also would not have been rendered obvious for at least the reasons set forth above, as well as for the additional features it recites. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

**V. Conclusion**

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-12, 14-16 and 20-32 are respectfully requested.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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Attachment:  
Petition for Extension of Time

Date: April 28, 2010

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